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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,241	10/23/2000	Nicole Barie	K 168	9230

7590 09/29/2003

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EXAMINER
PADMANABHAN, KARTIC

ART UNIT	PAPER NUMBER
1641	

DATE MAILED: 09/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/694,241	BARIE ET AL.	
	Examiner	Art Unit	
	Kartic Padmanabhan	1641	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: *none*.

   Claim(s) objected to: *none*.

   Claim(s) rejected: *1,3 and 5-15*.

   Claim(s) withdrawn from consideration: *none*.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

LONG V. LE
SUPERVISORY PATENT EXAMINER
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09/25/03

Continuation of 5. does NOT place the application in condition for allowance because: of reasons set forth in the prior office action. In addition, applicant's argument that Swan does not teach a conventional substrate is irrelevant, as such is not required in the claims, and the prior art need not teach that substrate depicted in Applicants' figure 1. Applicant's arguments that Swan does not teach the use of a protein are accurate; however, Chai-Gao or Wessa as secondary references have been relied upon for this feature. Applicant's arguments that Swan does not teach dextran alone as the material to be connected are erroneous. It is first noted that applicant's arguments distinguish between a coupling compound and the compound to be coupled, a distinction that does not appear anywhere in the claims. Rather, the claims merely require co-immobilization of a TRIMID-protein and dextran. Swan clearly teaches co-immobilization of a chemical specie and the coupling compound (Col. 3, lines 29-30). The coupling compound may be dextran (Col. 3, line 62). While the coupling compound of the reference may indeed be different than the coupling compound of the present invention, as long as dextran is co-immobilized with a protein (taught by secondary ref.), the claim limitations are deemed met, as the claims do not require the "coupling compound" to be the protein. In terms of the Hubbell reference, applicant argues that the reference does not teach dextran. While this may be true, the claims only generically refer to dextran and do not exclude derivatives of dextran. In addition, even if derivatives of dextran were excluded from the claims (which they haven't been), the use of dextran as a substitute for dextran derivatives would be viewed as a matter of optimization, which would have been obvious to one of ordinary skill in the art at the time of the invention (absent compelling evidence to the contrary). Applicant's arguments wth respect to Chai-Gao are based on the premise that the reference does not teach immobilization of dextran; however, as a secondary reference, it is only relied upon for teaching a TRIMID-protein used in immobilization and is not required to teach every element of the claims. Finally, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).